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OFFICE OF PETITIONS

In re Application of
Heidi Kay and Russell Fradin
Application No. 09/216,206
Filed: December 18, 1998
Attorney Docket No. B2745.0025

ON PETITION

This is a decision in response to the papers filed September 22, 2004, which are being treated as:
(1) a petition under 37 CFR 1.48(a) to correct inventorship in the above-identified application,
(2) a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.48(a)(2) and (a)(3),
(3) a petition under 37 CFR 1.183 seeking waiver of 37 CFR §§ 1.67 and 1.63 where they require that a supplemental declaration be executed by the named inventors.¹

The petition under 37 CFR 1.48(a) is **dismissed**.

The petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.48(a) is **dismissed**.

The petition under 37 CFR 1.183 requesting waiver of 37 CFR §§ 1.67 and 1.63 is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petitions Under 37 CFR 1.183 and 37 CFR 1.48(a)."

Facts:

The original declaration was executed by Heidi Kay and Russell Fradin on December 14, 1998.

On an unknown date, petitioner determined the inventorship listed for the application was incorrect.

Petitioner determined that both inventors listed in the declaration must be deleted. Petitioner determined that two inventors, David William Roth and Dylan Salisbury, needed to be added.

Petitioner sent correspondence to the last known address for all four individuals.

None of the individuals responded. Petitioner learned from the Post Office that the address for Ms. Kay was no longer a current address.

¹ Once an application has received a fully executed oath or declaration and been placed on the files for examination, the provisions of 37 CFR 1.47 no longer apply. Rather, the remedy for treating an inventor's refusal to sign a supplemental oath or declaration is waiver of 37 CFR 1.67. See MPEP 603.

Analysis:

A petition under 37 CFR 1.48(a) requires:

- (1) request along with fee under Rule 17(i) (\$130),
- (2) a statement from each person being added as an inventor and from each person being deleted as an inventor that error in inventorship occurred without deceptive intention on his or her part,
- (3) correct executed oath/dec (or oath/dec as permitted by 37 CFR 1.42, 1.43 or 1.47) and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee.

As to (2), neither or the inventors being deleted have supplied a statement that the error in inventorship occurred without deceptive intent.

As to (3), an executed oath or declaration complying with the requirements of 37 CFR 1.63 has not been submitted. Absent waiver of the this requirement, the petition cannot be granted.

A petition under 37 CFR 1.183 will only be granted when a petitioner establishes that extraordinary circumstances exist and that justice would be served by waiver of the rule.

Petitioner has failed to establish that petitioner is unable to locate the inventors.

In certain circumstances, mailing correspondence to a last known address and a lack of response might be construed as constructive refusal to sign papers or comply with requests made in the correspondence. However, petitioner has failed to provide any evidence to establish the last known address for Fradin, Roth, or Salisbury is a current address. The failure to have the mail returned alone will not establish the address is recent and current.

The petition clearly indicates the last known address for Ms. Kay is no longer a current address.

Petitioner must take reasonable and appropriate steps to locate all four inventors. Reasonable steps may include, but are not limited to, contacting directory assistance for a current telephone number and internet searches. Contact by telephone would result in the inventor learning of the change and either clearly refusing to cooperate or providing petitioner with a current address.

The following information is for petitioner's benefit only and merely provided as a courtesy. The Office does not verify that the information is correct nor does the information, if inaccurate, release petitioner from the obligation to exercise diligent effort to find the nonsigning inventors. An internet search indicates:

Ms. Heidi Kay may now reside at 990 Governors Bay Dr, Redwood City, CA 94065.

Mr. Russell Fradin may now reside at 26 Crane Rd, Lloyd Harbor, NY 11743.


Mr. Dylan Salisbury may now reside at 17945 Calle Central, Morgan Hill, CA 95037.

Future correspondence may be directed to:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (703) 872-9306
Attn: Office of Petitions

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.



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